

RESPONSE
Examiner: SON, Linh L.D.

Serial No. 09/663281
Atty. Docket No.: 46354.010200

REMARKS/ARGUMENTS

Claims 1-13 and 16-25 are currently pending in the above-referenced patent application. Applicants thank the Examiner for acknowledging receipt of the certified copy of the priority documents.

Claim Rejections – 35 USC §103

The Examiner rejected claims 1-13 and 16-21 under 35 USC §103(a) as being unpatentable over Bostley, III et al, U.S. Patent NO. 6,201,871B1 (referred to herein as “Bostley”), in view of Cardano Grilles (referred to herein as “Grilles”). Applicants respectfully traverse the rejection. It appears that, in formulating the rejection, the Examiner has misconstrued the term “mask code” as used in the currently pending claims. The Examiner appears to interpret a “mask code” as being similar to the cardboard cut-outs used in the Grille technique discussed above. As noted in page 5, line 22 through page 6, line 5, of the above-referenced patent application, as filed, the “mask code” is not a simple overlay. In the present invention, the characters of the pseudorandom string are selected in positional order determined by the mask code (e.g., where the mask code is 6359, the order will be the sixth, third, fifth, and ninth character from the pseudorandom string). By contrast, in a grille cipher, the characters are read through the holes in the grille in sequential order. Moreover, in the grille cipher, a message must first be written through the holes in the grille before the remaining squares are populated with random letters. In the present invention, the volatile identification code is not predetermined in this way, but is generated simply by applying the “mask code” to any pseudorandom string. Therefore, Applicants assert that the invention is distinguishable over the prior art, and notification to that effect is respectfully requested.

Applicants also assert that the Bostley reference teaches away from Applicants’ invention as claimed. Bostley teaches providing secure storage and processing of authentication keys, or “A-keys”, for wireless devices. The security is achieved by encrypting the A-keys using a secure processor to which human access is prevented, such as by encasing the processor in concrete (see column 2, lines 8-44). Furthermore, Bostley teaches that the encryption of the A-keys requires sophisticated and complex computer-processed algorithms, such as the Diffie-Hellman algorithm and Blowfish encryption methods discussed in column 6, lines 1-36. By contrast, Applicants’ invention does not require such sophisticated and complex algorithms, nor does it prevent human

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access to the encryption keys. In the present invention, as recited in the pending claims, a one-time use, volatile identification code is generated both by a human user (who generates the identification code by applies a mask code, or selection code, to a pseudorandom string) and also by a host computer. The host computer merely verifies that the volatile identification code matches the anticipated response. See, e.g., page 5, line 22 through page 6, line 5, of the above-referenced application, as filed. Bostley clearly teaches away from the type of human interaction recited in Applicants' pending claims. The Court of Appeals for the Federal Circuit has consistently held that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." In re Fine, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). The fact that Bostley specifically teaches away from the present invention as claimed renders that reference inapplicable to the pending claims. Therefore, Applicants assert that the pending claims are distinguishable over the prior art, and notification to that effect is requested.

Bostly also does not provide a motivation to combine the disclosure therein with that of Grilles. As summarized by the Examiner, Grilles teaches the use of a human-operated cardboard piece into which openings have been cut at various places. A message can then be created by entering the desired text in order in the openings, and filling in any blank spaces with random letters or words to create a false message. Bostley teaches away from even allowing humans to interact with the system, let alone requiring the level of human interaction taught in Grilles. As the Court of Appeals for the Federal Circuit has stated, "When prior art references require selective combination ... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985). See also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. Ex parte Hiyamizu 10 USPQ2d 1393 (BPAI 1988). "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998). Therefore, Applicants assert that Bostley specifically teaches away from the combination suggested by the Examiner, and Grilles fails to provide a motivation to combine the references as recited by the Examiner. Thus, Applicants

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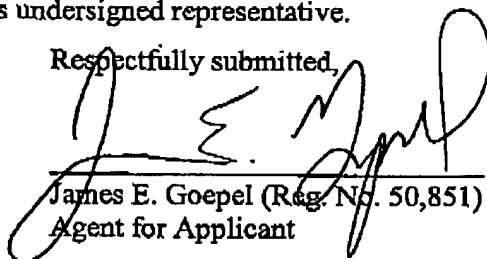
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assert that the pending claims are distinguishable over the prior art, and notification to that effect is requested.

CONCLUSION

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that the currently pending claims are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,


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